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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389 7590 01/27/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PHAN, HUY Q				
ART UNIT		PAPER NUMBER		
2617				
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01/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

HUY Q. PHAN

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28, 29, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28, 29, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/12/2009 has been entered.

Response to Amendment

2. This Office Action is in response to Amendment filed on date: 01/12//2009.
Claims 28, 29, 32 and 33 are still pending.
Claims 1-27 and 30-31 have been cancelled.

Response to Arguments

3. Applicant's arguments with respect to the amended limitation of claims 28, 29, 32 and 33 have been fully considered but they are not persuasive.

Applicant argued that

Lynch et al. fails to teach or suggest a "...means for receiving a message that includes a first list including a plurality of network identifiers that are available for a potential handover, from the communication network while a call is in progress..." recited in Claim 29, 32 and 33 and similarly recited in Claim 28.

The examiner respectfully disagrees with the applicant's argument. Lynch specifically discloses the updating method for downloading new system identification

(SID) list into a mobile phone (see the title) during the handoff ("hand-off" see col. 8, lines 8-10, line 41; col. 11, lines 55-58; col. 12, lines 1-5 and fig. 5). Since, figure 5 of Lynch particularly shows that the mobile phone could receive a preferred SID list (read on the claimed limitation "a first list") which is available for hand-off (see col. 12, lines 2-5) from the communication network (see col. 11, lines 53-58 and fig. 1) while a call is in progress ("hand-off sequence" see col. 12, lines 1-2); therefore, Lynch discloses the claimed limitations "...means for receiving a message that includes a first list including a plurality of network identifiers that are available for a potential handover, from the communication network while a call is in progress..." recited in Claim 29, 32 and 33 and similarly recited in Claim 28.

In response to applicant's arguments that "Lynch et al. teaches away from providing handover between mobile communication networks while a call is in progress as evidenced in col. 19, lines 39 – 51" which describes that "It is noted that an updated SID list downloaded into a subscriber unit handset after communication has begun may result in the recognition that communication has been established using a service provider that is now considered inappropriate on the basis of the updated preferred SID list. Consequently, it may be necessary to apply certain safeguards to prevent re-registration with a new service provider once communication has already begun. While such circumstances are considered rare, their occurrence may jeopardize high quality communication especially when hand-off is required. The programming that prevents re-registration during an ongoing telephone call is easily accomplished by one skilled in this art, and requires no further elaboration." The examiner respectfully disagrees with the applicant's argument. The cited portion describes that during the ongoing call and

when the hand-off is required, the re-registration with a new service provider can be prevented by applying certain safeguards or programming. Since such circumstances can be prevented, therefore the high quality communication may not be jeopardized when hand-off is required. Consequently, Lynch does not teach away from providing handover between mobile communication networks while a call is in progress (also see "hand-off" col. 8, lines 8-10, line 41; col. 11, lines 55-58; col. 12, lines 1-5 and fig. 5).

In response to applicant's arguments against the references individually ("Regarding Daly, that reference fails to teach or suggest selecting one of the plurality of network identifiers for handover between an active mobile communication network and a mobile communication network corresponding to the selected one network identifier while a call is in progress" see REMARKS page 5), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this instant case, Lynch is used to teach the dispute claimed limitation (see the 103 rejection below).

In response to applicant's arguments against the references individually ("Grandhi et al. fails to disclose or suggest selecting one of the plurality of network identifiers for handover between an active mobile communication network and a mobile communication network corresponding to the selected one network identifier while a call is in progress" see REMARKS page 5), one cannot show nonobviousness by attacking

references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this instant case, Lynch is used to teach the dispute claimed limitation (see the 103 rejection below).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 28 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)) indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.

Applicant claims a method comprising steps of receiving and comparing being of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally or without a machine.

While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory

category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I) Claims 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited) in view of Daly (US-6,122,503; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 1, 12) for a mobile communication system (fig. 1, 10) comprising:

receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-8) that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-5) and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

means for receiving a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

means for comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-5) and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 33, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

a receiver (fig. 1, 12) for receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-5) that are available for a potential handover ("hand-off" see col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

a comparator (fig. 1, 12) for comparing ("compared", col. 12, lines 1-5) the received first list with a second list ("received SIDs"; col. 12, lines 1-5) which includes at least one network identifier and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

II) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited) in view of Daly (US-6,122,503; previously cited) and further in view of Grandhi (US 6,125,280; previously cited).

Regarding claim 32, Lynch discloses a mobile communications network (fig. 1, 10) or component (fig. 1, 12) thereof including:

means for receiving by a user equipment (fig. 1, 12) a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5);

means for comparing ("compared", col. 12, lines 1-5) by the user equipment the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier from the plurality of network identifiers ("received SIDs"; col. 12, lines 1-5) and is internally stored in the user equipment ("stored"; col. 12, lines 1-5); and

means for receiving from user equipment communicating with the network an indication of a preferred other network (fig. 5, step 507-510 and col. 11, lines 7-20).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying to the user equipment neighboring cell information for the preferred other network based on the indication. However in analogous art, Grandhi teaches means for supplying neighboring cell information for the preferred other network based on the indication ("provides automatic identification of neighbor cells, and configuration of neighbor cell information";

see col. 3, lines 19-23); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network of Lynch and Daly as taught by Grandhi in order to improve the handoff process in the wireless communication system, since Grandhi specifically discloses that "Handoff processes use neighbor information to help decide the most appropriate sector or cell to serve a call" (col. 1, lines 53-58).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Phillips discloses "In a receiver which is roaming in a Network, a frequency scan list is stored which includes a list of frequencies for which there is a high probability that an identifier match will be obtained (see specification).

b) Grube discloses "Having identified the location of the targets, the process proceeds to step 492 where an ordered bit loading table for the call is generated. The ordered call bit loading table is generated by first accessing the database of site bit loading tables to retrieve a site bit loading table for each of the sites supporting one of the at least two targets, i.e., the sites that have at least one of the targets affiliated therewith. Having retrieved the site bit loading tables, the tables are compared, on a carrier channel by carrier channel basis, to determine the lowest bit loading for each carrier channel" (see specification).

c) Barber discloses "With the Roam Saver carrier selection mode, the cellular telephone first prefers service through a home carrier and then through a carrier broadcasting a SID matching a SID on the preferred list, but never denies service to emergency or non-emergency destinations if any SID is detected" (see specification).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on 571-272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/
Examiner, Art Unit 2617
Date: 01/21/2009